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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/175,589	10/20/1998	ANDREA M. JACOBSON	12369.5US01	7081

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[REDACTED] EXAMINER

COLBERT, ELLA

[REDACTED] ART UNIT      [REDACTED] PAPER NUMBER

2172

DATE MAILED: 03/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application N .	Applicant(s)
	09/175,589	JACOBSON
	Examiner Ella Colbert	Art Unit 2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Peri d for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 07 January 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disp sition of Claims**

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Pri rity under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
  - a) All
  - b) Some \*
  - c) None of:  
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

<ol style="list-style-type: none"> <li>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing R view (PTO-948)</li> <li>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.</li> </ol>	<ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____.</li> <li>5)<input type="checkbox"/> Notice of Informal Pat nt Application (PTO-152)</li> <li>6)<input type="checkbox"/> Other: _____.</li> </ol>
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## DETAILED ACTION

1. Claims 1-22 are presented for examination. Claims 1, 13, and 17 have been amended in this communication filed 01/07/02, entered as Request for RCE, paper no. 13.

### ***Claim Objections***

2. Claims 1, 13, and 17 are objected to because of the following informalities: Claim 1, page 2, lines 3 recites "... identifies an electronic records". Claim 1 would be better recited "... identifies an electronic record." Claims 13 and 17 have a similar problem. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-4, 13-15, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by (US 5,245,532) Mourier.

With respect to claim 1, Mourier teaches the electronic tag is created that uniquely identifies an electronic record (col. 4, lines 10-12 and lines 49-68 and col. 5, lines 1-16), storing the electronic tag (col. 4, lines 12-15), distributing the electronic record associated with the electronic tag (col. 4, lines 15-18 and col. 8, lines 44-57).

With respect to claim 2, purging the electronic record comprising the steps of deleting the electronic record and selectively deleting the electronic tag (col. 1, lines 42-49).

With respect to claim 2, Mourier teaches, purging the electronic record comprising the steps of deleting the electronic record and selectively deleting the electronic tag (col. 9, lines 47-55 and lines 59-68 and fig. 19B).

With respect to claim 3, Mourier teaches, the step of storing the electronic record (col. 3, lines 24-38).

With respect to claim 4, Mourier teaches determining whether the recipient may purge the electronic mail (col. 9, lines 20-28).

With respect to claim 13, Mourier teaches a processor (col. 2, lines 26-32) and a memory (col. 3, lines 20-22).

This independent claim is also rejected for the similar rationale given for claim 1.

With respect to claim 14, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 15, this dependent claim is rejected for the similar rationale given for claim 4.

With respect to claim 17, this independent claim is rejected for the similar rationale given for claim 1.

With respect to claim 18, this dependent claim is rejected for the similar rationale given for claim 2.

With respect to claim 19, this dependent claim is rejected for the similar rationale given for claim 3.

With respect to claim 20, this dependent claim is rejected for the similar rationale given for claim 4.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-12, 16, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,245,532) Mourier in view of (US 5,786,817) Sakano et al, hereafter Sakano.

With respect to claim 5, Mourier teaches a user profile (col. 5, lines 26-45); a reference code, an electronic tag (col. 6, lines 17-22) and a network user's user profile, (col. 2, lines 58-68 and col. 3, lines 1-2).

Mourier did not teach a registry, analyzing a network user's workstation specifications, analyzing a network user's profile, the electronic tag being generated from information analyzed in the network user's workstation specification.

Sakano discloses a registry (col. 4, lines 9-16), analyzing a network user's workstation specifications (col. 2, lines 15-35), analyzing a network user's profile (col. 4, lines 12-16), and wherein the electronic tag is generated from information analyzed in the network user's workstation specification (col. 4, lines 12-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a registry, analyze a network user's workstation specifications, analyze a network user's profile, and wherein the electronic tag is generated from information analyzed in the network user's workstation specification and to combine Mourier's network user's user profile, reference code, and electronic tag with Sakano's registry, analyzing a network user's workstation specifications, analyzing a network user's profile, the electronic tag being generated from information analyzed in the network user's workstation specification because such a combination would allow Mourier and Sakano's systems to manage electronic mail without wasteful memory space and without having a time-consuming process to retrieve saved electronic mail.

With respect to claim 6, Mourier teaches reading stored electronic tags and generating an electronic tag in response to accessing an electronic record (col. 4, lines 18-36). Sakano discloses reading stored electronic tags and generating an electronic tag in response to accessing an electronic record (col. 4, lines 9-16). Together Mourier and Sakano teach the claim limitations of claim 6.

With respect to claim 7, this dependent claim is rejected for the similar rationale given for claim 6.

With respect to claim 8, Mourier teaches a classification code and an index code (col. 4, lines 49-68, col. 5, lines 1-6, and col. 8, lines 24-34). Sakano discloses a classification code and an index code (col. 4, lines 35-65). Together Mourier and Sakano teach the claim limitations of claim 8.

With respect to claim 9, Mourier teaches business E-mail, personal E-mail, intramail, bulletin board, minutemail, and purgemail (col. 7, lines 7-16). Sakano discloses business E-mail, personal E-mail, intramail, bulletin board, minutemail, and purgemail (col. 4, lines 9-16)

The nature of E-mail does not entitle any patentable weight.

With respect to claim 10, Mourier teaches the index code identifies the contents of an electronic record and the sender or recipient of the electronic record (col. 7, lines 34-41). Sakano discloses the index code identifies the contents of an electronic record and the sender or recipient of the electronic record (col. 4, lines 1-16). Together Mourier and Sakano teach the claim limitations of claim 10.

With respect to claim 11, this dependent claim is rejected for the similar rationale given for claim 9.

With respect to claim 12, this dependent claim is rejected for the similar rationale given for claims 5 and 6.

With respect to claim 16, this dependent claim is rejected for the similar rationale given for claim 5.

With respect to claim 21, this independent claim is rejected for the similar rationale given for claim 5.

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With respect to claim 22, this independent claim is rejected for the similar rationale given for claim 6.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure.

Schreiber et al (US 5,893,099) discloses a system and method for processing electronic mail.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Mrs. Kim Vu can be reached on 703-305-4393.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 for After-Final communications, 703-746-7239 for Official communications and 703-746-7240 for Non-Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

*E. Colbert*  
E. Colbert  
March 21, 2002

*Kim Vu*  
KIM VU  
SUPERVISORY PATENT EXAMINER  
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